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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Gary M. Nath
NATH & ASSOCIATES PLLC
6th Floor
1030 15th Street, N.W.
Washington, DC 20005

EXAMINER	
OLSON, ERIC	
ART UNIT	**PAPER NUMBER**
1623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/774,694	GIL-AD ET AL.	
	Examiner	Art Unit	
	Eric S. Olson	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *70-77* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *70-77* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

This office action is a response to applicant's communication submitted July 9, 2007 wherein claims 1-69 are cancelled and new claims 70-77 are introduced. This application is a continuation in part of US application 10/432875, filed September 16, 2003, now pending, which is a national stage application of PCT/IL01/01105, filed November29, 2001, which claims priority to foreign application IL139975, field November 29, 2000.

Claims 70-77 are pending in this application.

Claims 70-77 as amended are examined on the merits herein.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 21, 2007 has been entered.

Applicant's amendment, submitted July 9, 2007, with respect to the rejection of instant claims 4, 5, and 9-12 under 35 USC 112, second paragraph for reciting the indefinite phrases "phenylpropylamine compound" and "phenoxy-3-propylamine derivative," and other similar phrases, has been fully considered and found to be

persuasive to remove the rejection as the rejected clams have been cancelled and new claims 70-77 do not recite the indefinite phrases. Therefore the rejection is withdrawn.

Applicant's amendment, submitted July 9, 2007, with respect to the rejection of instant claims 1-3, 7, 8, 14, 15, and 63 under 35 USC 112, first paragraph for lacking enablement for any cyclic psychotropic agent, SSRI, SSNRI or antidepressant or antipsychotic whatsoever, has been fully considered and found to be persuasive to remove the rejection as the rejected clams have been cancelled and new claims 70-77 are drawn only to compositions containing specific monocyclic antidepressants. Therefore the rejection is withdrawn.

Applicant's amendment, submitted July 9, 2007, with respect to the rejection of instant claims 1-3, 7, 8, 14, 15, and 63 under 35 USC 112, first paragraph for lacking enablement for any cyclic psychotropic agent, SSRI, SSNRI or antidepressant or antipsychotic whatsoever, has been fully considered and found to be persuasive to remove the rejection as the rejected clams have been cancelled and new claims 70-77 are drawn only to compositions containing specific monocyclic antidepressants. Therefore the rejection is withdrawn.

Applicant's amendment, submitted July 9, 2007, with respect to the rejection of instant claims 1-4, 7-15, and 63 under 35 USC 102(b) for being anticipated by Beltner, has been fully considered and found to be persuasive to remove the rejection as the

rejected clams have been cancelled and new claims 70-77 are drawn only to compositions containing specific monocyclic antidepressants nit recited by Beltner. Therefore the rejection is withdrawn.

The provisional rejection of instant claims 1-10, 14, 15, and 61-69 under the doctrine of obviousness-type double patenting as claiming the same invention as claims 184-186, 197, 198, and 203-206 of copending application 10/432875, is withdrawn in view of the cancellation of said claims in 10/432875.

The following new grounds of rejection are introduced:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 70-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Meadows et al. (US patent 6927223, cited in PTO-892) Meadows et al. discloses a method for treating cancer comprising administering a serotonin reuptake inhibitor or a selective serotonin reuptake inhibitor such as fluoxetine, by various routes of administration including topically. (column 2, lines 45-55) Topical preparations of these

agents can be administered as creams, milks, gels, dispersions, microemulsions, lotions, impregnated pads, ointments, sticks, aerosols, or soaps. (column 7, lines 30-35) With regard to the specific clinical indications recited in instant claims 74-76, the intended use of a composition does not distinguish the composition from prior art compositions having the same ingredients that could also be used for the same purpose. In the instant case, the compositions of Meadows et al. could be used for treating nonmalignant skin proliferative disorders, for example psoriasis. Therefore Meadows et al. anticipates the claimed invention.

Claims 70 and 72-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomasson. (US patent 6683114, cited in PTO-892) Thomasson discloses a formulation adapted for the treatment of psoriasis containing a norepinephrine reuptake inhibitor. (column 1, lines 62-67) Norepinephrine reuptake inhibitors include Reboxetine (column 2, lines 62-67) and Venlafaxine. (column 3, lines 18-22) Various routes of administration besides oral administration are possible. (column 4, lines 54-56) In one example, a topical formulation containing the monocyclic antidepressant tomoxetine is disclosed. (column 7, lines 33-42, example 10) With regard to the specific clinical indications recited in instant claims 74-76, the intended use of a composition does not distinguish the composition from prior art compositions having the same ingredients that could also be used for the same purpose. In the instant case, the compositions of Thomasson could be used for treating skin proliferative disorders other than psoriasis,

for example melanoma. Therefore the claimed invention is anticipated by Thomasson et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomasson. (US patent 6683114, cited in PTO-892) The disclosure of Thomasson is discussed above. Thomasson does not specifically exemplify a topical composition comprising reboxetine or venlafaxine.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the topical composition of formulation example 10 of Thomasson using reboxetine or venlafaxine in place of tomoxetine. One of ordinary skill in the art would have been motivated to practice the invention in this manner because Thomasson already discloses that reboxetine and venlafaxine are useful active agents for preparing pharmaceutical compositions for treating psoriasis. One of ordinary skill in the art would reasonably have expected success because preparing a conventional pharmaceutical dosage form such as that recited in formulation example 10 is well within the ordinary and routine level of skill in the art.

Thus the invention taken as a whole is *prima facie* obvious.

Claims 70-76 rejected under 35 U.S.C. 103(a) as being unpatentable over Meadows et al. (US patent 6927223, cited in PTO-892) in view of Ekins. (US patent publication US2002/0013372, cited in PTO-892) The disclosure of Meadows et al. is discussed above. Meadows et al. does not disclose a composition wherein the active agent is norfluoxetine.

Ekins refers to both fluoxetine and norfluoxetine as selective serotonin reuptake inhibitors. (p. 3, paragraph 0014)

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the pharmaceutical compositions of Meadows et al. using norfluoxetine as the active ingredient. One of ordinary skill in the art would have been motivated to practice the invention in this manner because Meadows et al. already discloses compositions comprising SSRI active agents in general. One of ordinary skill in the art would reasonably have expected success because preparing a conventional pharmaceutical dosage form such as that recited in formulation example 10 is well within the ordinary and routine level of skill in the art.

Thus the invention taken as a whole is *prima facie* obvious.

Claims 70-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomasson. (US patent 6683114, cited in PTO-892) in view of Gatch et al. (Reference included with PTO-892) The disclosure of Thomasson is discussed above. Thomasson does not specifically exemplify a topical composition comprising nisoxetine.

Gatch et al. refers to nisoxetine as a selective norepinephrine reuptake inhibitor. (p. 104, right column, second paragraph)

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the pharmaceutical compositions of Meadows et al. using nisoxetine as the active ingredient. One of ordinary skill in the art would have been motivated to practice the invention in this manner because Meadows et al. already discloses compositions comprising selective norepinephrine reuptake inhibitor active agents in general. One of ordinary skill in the art would reasonably have expected success because preparing a conventional pharmaceutical dosage form such as that recited in formulation example 10 is well within the ordinary and routine level of skill in the art.

Thus the invention taken as a whole is *prima facie* obvious.

The following rejections of record in the previous office action are maintained:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 70-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Sawynok et al. (US patent 6211171, reference of record in previous office action) Sawynok et al. discloses a composition comprising a specific tricyclic, second generation, or third generation antidepressant preferably formulated for local use, as a saline solution, cream, gel, or spray, for example, (column 4, lines 30-35, column 10, lines 37-67) as disclosed in instant claims 1-3 and 14-15. The antidepressant is preferably a second or third generation antidepressant including venlafaxane, (column 10, lines 33-36) as disclosed in instant claims 4-6. Although Sawynok et al. suggests that these compositions could be used for the treatment of neuropathic pain, the compositions comprise the same ingredients as those of the claimed invention disclosed to possess activity against proliferative dermatological diseases. Thus the compositions of Sawynok et al. are inherently the same as the claimed invention of instant claims 61-69. Therefore Sawynok et al. anticipates the instant claims.

Response to Argument: Applicant's arguments, submitted July 9, 2007, with respect to the above grounds of rejection, have been fully considered and not found persuasive to remove the rejection. Applicant argues that Sawynok et al. does not teach a composition comprising a monocyclic antidepressant. However, the inclusion of venlafaxine, which is taught by Sawynok et al., in the recited compounds in instant claim 71 indicates that venlafaxine is reasonably considered to be a monocyclic antidepressant.

Applicant also argues that Sawynok et al. does not disclose an amount of active agent sufficient to be therapeutically effective against a hyperproliferative skin disorder.

However, the exact amount of active agent in a pharmaceutical composition does not ordinarily render it unsuitable for a particular therapeutic use, as a practitioner would simply administer more or fewer doses of the composition, or administer it more or less frequently to compensate for differences in the concentration of active agent. According to the instant specification, a therapeutically effective amount sufficient to have an **antiproliferative, anti-inflammatory, or other effect**. (p. 12, lines 6-11) Although an amount from 0.01-1% is preferred, the examples provided on pp. 25-29 contain amounts of active agent ranging up to 5%. It is noted that the instant specification provides these ranges as being useful for exerting either an antiproliferative or an anti-inflammatory effect, or the amount necessary for exerting other effects. Nowhere in the instant specification is a distinction drawn between an antiproliferative amount of active agent and an anti-inflammatory amount. Therefore the compositions of Sawynok et al. are considered to be suitable for treating proliferative skin disorders.

Therefore the rejection is maintained.

Conclusion

No claims are allowed in this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric S. Olson whose telephone number is 571-272-9051. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on (571)272-0627. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric Olson
Patent Examiner
AU 1623
7/25/07

Anna Jiang
Supervisory Patent Examiner
AU 1623